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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/568,170	11/13/2006	Frank B. Stamps	0837RF-H532-US	5513
38441	7590	12/09/2010	EXAMINER	
LAW OFFICES OF JAMES E. WALTON, PLLC			BURCH, MELODY M	
1169 N. BURLESON BLVD.				
SUITE 107-328			ART UNIT	PAPER NUMBER
BURLESON, TX 76028			3657	
			NOTIFICATION DATE	DELIVERY MODE
			12/09/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

JIM@WALTONPLLC.COM

Office Action Summary	Application No.	Applicant(s)	
	10/568,170	STAMPS ET AL.	
	Examiner	Art Unit	
	Melody M. Burch	3657	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 19 October 2010.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-6,8,10-14,17,19 and 20 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-6,8,10-14,17,19 and 20 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>11/29/10</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/19/10 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3, 5, 6, 11, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Application 5788372 to Jones et al.

Re: claims 1, 3, 5, 20. Jones et al. show a damper having an adjustable spring rate, comprising: a piston as labeled having an axis, an outer surface, and opposing ends; a housing 51f; at least one elastomeric seal 55f in sealing contact with the outer surface of the piston, the at least one seal being coaxial with the piston and limiting movement of the piston to a path along the axis of the piston, the at least one seal also defining fluid chambers 61f" and 61f' adjacent the ends of the piston, the at least one seal also being fixed to the housing; a primary passage 42f extending through the piston from one end to the opposing end of the piston, the primary passage providing fluid

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passage between the fluid chambers; and a selectively switchable valve 20f using the 1b embodiment disposed within the piston and in fluid communication with the fluid passing through the primary passage, the selectively switchable valve being adapted for controlling a flow of fluid from one of the chambers to another of the chambers through the primary passage, such that when the selectively switchable valve is open, the flow of fluid through the primary passage is not resisted by the selectively switchable valve in either direction; further, when the selectively switchable valve is closed, the flow of fluid through the primary passage is restricted in both directions by the selectively switchable valve; and wherein when the flow of fluid through the primary passage is permitted, movement of the piston is resisted by a first spring rate due to a shear force required to cause shear deflection of the seals; and when the flow of fluid through the primary passage is restricted, movement of the piston is resisted by a second spring rate due to a fluid force required to cause bulging deflection of the seals. See annotated figure 4 below.

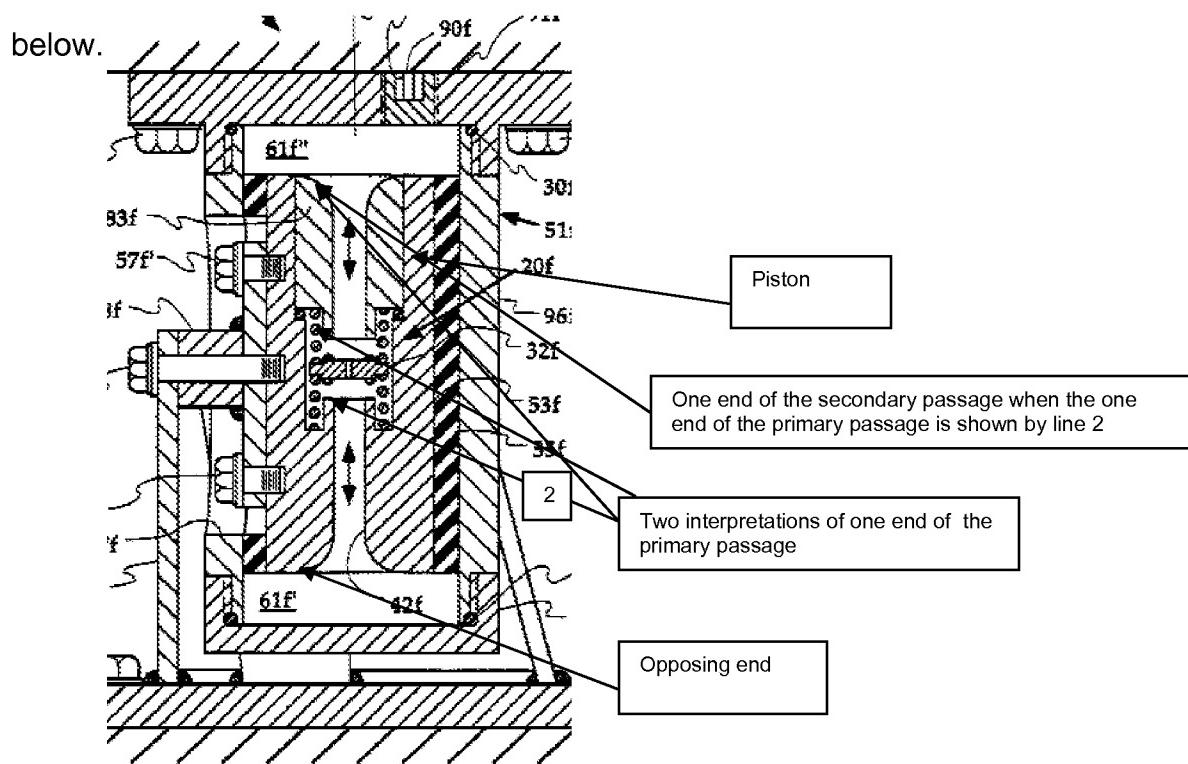


Fig. 4

Jones et al. are silent with regards to the at least one seal being a plurality of seals. In *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960) the court held that mere duplication of parts has no patentable significance unless a new and unexpected result is produced.

Re: claims 6 and 11. Jones et al., as modified, show in figure 4 of Jones et al. the limitation of s secondary passage as labeled in the annotated figure 4 on pg. 3 of the Office action extending through the piston from one end to the opposing end of the piston providing fluid passage between the fluid chambers.

4. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al. in view of US Patent 5535861 to Young.

Re: claim 2. Jones et al. or as modified are silent with regards to the elastomeric seals being formed of layers of an elastomeric material and a rigid non elastomeric material.

Young teaches the use of elastomeric seals being formed of layers of an elastomeric material 23 and a rigid non elastomeric material 26.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the elastomeric seals of Jones et al. or as modified to have included layers of an elastomeric material and a rigid non elastomeric material, as taught by Young, in order to provide a means of having seals with adequate stiffness for improved product reliability.

5. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al. in view of US Patent Application 2006/0162778 to Nichols et al.

Jones et al. or as modified include a switchable valve that is pressure operated but are silent with regards to the switchable valve being electrically operated.

Nichols et al. teach in paragraph [0021] that pressure operated valves may be switched to electrically operated solenoid valves.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the pressure operated valve of Jones et al. or as modified to have been electrically operated, in view of the teachings Nichols et al., in order to provide an alternate but functionally equivalent means of enabling and restricting fluid flow.

6. Claims 6, 8, 10, 11, 13, 17, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al. in view of US Patent 2774553 to Jensen.

Re: claims 6, 11, and 13. In one interpretation Jones et al., as modified, are silent with regards to the secondary passage communicating the fluid chambers.

Jensen teaches in figure 5 the limitation of a damper comprising a secondary passage 146 communicating fluid chambers 110, 112 which is located in the piston 108.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the damper of Jones et al. or as modified to have included a secondary passage located in the piston, in view of the teachings of Jensen, in order to provide damping in both directions as suggested by Jensen.

Re: claims 8 and 17. Jones et al., as modified, are silent with regards to the damper comprising a bypass passage for limiting the pressure imbalance between the fluid chambers.

Jensen teaches in figure 5 a damper comprising a bypass passage 148 located in the piston 108.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the damper of Jones et al. or as modified to have included a bypass passage in the piston, as taught by Jensen, in order to provide a means of relieving pressure in one of the chambers when it exceeds a certain limit as suggested by Jensen.

Re: claims 10 and 19. Jensen teaches in figure 5 the use of a spring loaded bypass valve located within the bypass passage 148.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the bypass passage of Jones et al., as modified, to have included a bypass valve, as taught by Jensen, in order to provide a means of selectively relieving pressure based on the pressure achieving a desired limit selecting depending on the particular application.

7. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al. in view of US Patent 2774553 to Jensen as applied to claim 11 above, and further in view of US Patent 5535861 to Young.

Re: claim 12. Jones et al., as modified, are silent with regards to the elastomeric seals being formed of layers of an elastomeric material and a rigid non elastomeric material.

Young teaches the use of elastomeric seals being formed of layers of an elastomeric material 23 and a rigid non elastomeric material 26.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the elastomeric seals of Jones et al., as modified, to have included layers of an elastomeric material and a rigid non elastomeric material, as taught by Young, in order to provide a means of having seals with adequate stiffness for improved product reliability.

8. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al. in view of US Patent 2774553 to Jensen as applied to claim 11 above, and further in view of US Patent Application 2006/0162778 to Nichols et al.

Jones et al., as modified, include a switchable valve that is pressure operated but are silent with regards to the switchable valve being electrically operated.

Nichols et al. teach in paragraph [0021] that pressure operated valves may be switched to electrically operated solenoid valves.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the pressure operated valve of Jones et al., as modified, to have been electrically operated, in view of the teachings Nichols et al., in order to provide an alternate but functionally equivalent means of enabling and restricting fluid flow.

Claim Objections

9. Claim 5 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 5 fails to further limit independent claim 1 since claim 1 already includes a primary passage extending through the piston.

Claim Rejections - 35 USC § 112

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claim 8, 10, and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Re: claim 8. Claim element “means for limiting the pressure imbalance” is a means (or step) plus function limitation that invokes 35 U.S.C. 112, sixth paragraph. However, the written description fails to clearly link or associate the disclosed structure, material, or acts to the claimed function such that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function. It is unclear whether Applicant intends for the means for limiting the pressure imbalance to be the bypass passage itself or the bypass valve in the bypass passage later recited in claim 10 which depends from claim 8.

Applicant is required to:

- (a) Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or
- (b) Amend the written description of the specification such that it clearly links or associates the corresponding structure, material, or acts to the claimed function without introducing any new matter (35 U.S.C. 132(a)); or
- (c) State on the record where the corresponding structure, material, or acts are set forth in the written description of the specification that perform the claimed function.

For more information, see 37 CFR 1.75(d) and MPEP §§ 608.01(o) and 2181.

Re: claim 20. The phrase "the primary passage" in line 12 is indefinite. It is unclear to the Examiner whether the primary passage is intended to be the same or different from "the passage" earlier recited.

Claim 10 is rejected due to its dependency from claim 8.

Response to Arguments

12. Applicant's arguments filed 10/19/10 have been fully considered but they are not persuasive. Examiner agrees that in the interview conducted on 10/13/10 Examiner stated that it appeared that the proposed amendments submitted after final would overcome the Jones et al. reference. It should be noted; however, that the amendments only overcame the first embodiment of Jones et al. shown in figures 1b and 2 in which the switchable valve was positioned exterior to the piston. Accordingly,

the rejections using the figure 4 embodiment of Jones et al. have been maintained since the switchable valve in this embodiment is positioned within the piston.

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melody M. Burch whose telephone number is 571-272-7114. The examiner can normally be reached on Monday-Friday (6:30 AM-3:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Siconolfi can be reached on 571-272-7124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Melody M. Burch/
Primary Examiner, Art Unit 3657